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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,650	03/25/2004	Jean-Claude Gasquet	1948-4841	6110
27123	7590	12/12/2006	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			HAN, JASON	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/808,650	Applicant(s) GASQUET ET AL.	
	Examiner Jason M. Han	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5 and 17 is/are rejected.
- 7) ☒ Claim(s) 3,4 and 7-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Page 6, filed November 20, 2006, with respect to Claims 1, 3-5, 7-8, 10, and 17 rejected under 35 U.S.C. 103(a) have been fully considered and are persuasive. The prior art rejection of claims has been withdrawn.
2. However, Applicant's arguments concerning the Double Patenting rejection have been fully considered and are not persuasive. Applicant's argument, "While Karker discusses the mounting of alignment ware to a metal substrate using spot welding, Karker does not recite or imply the fixing of a power light-emitting diode to a metallic heat radiating element coated with a layer of metal chosen to perpetuate both a solid and thermally conductive bond between the diode and radiating element when attached via laser spot welding" [Page 5], has misconstrued the Examiner's obvious rejection. To recapitulate the previous Office Action, and as restated below, Claims 1, 5, and 17 of the current application are not patentably distinct over Claims 1, 8, and 10-11 of Applicant's U.S. Patent No. 6,821,143. Both the current application and former patent commonly recite a light-emitting diode having a metallic base/electrode that are laser spot welded to a heat-radiating element, with the exception that the patent does not provide the heat-radiating element being coated with a layer of metal. Thus, the Karker reference was applied under the motivation that it would have been obvious to one ordinarily skilled in the art at the time of invention to provide the heat-radiating element with a layer of metal, as corroborated by the Karker principle teaching of laser spot welding a metal insert pad to a metal substrate having multiple layered structures

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incorporating a metal (i.e., copper alloys) [Paragraphs 26-28], in order to facilitate the laser spot weld/absorption of laser light energy.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 5, and 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1, 8, and 10-11 of U.S. Patent No. 6,821,143 in view of Karker et al. (U.S. Publication 2003/0002825 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because both the current application and former patent commonly recite (note claim comparison table below) a light-emitting diode having a metallic base/electrodes that are laser spot welded to a heat-radiating element, with the exception that the patent does not provide the teaching of a heat-radiating element being coated with a layer of

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metal. It would have been obvious to one ordinarily skilled in the art at the time of invention to provide the heat-radiating element with a layer of metal, as corroborated by the Karker teaching of laser spot welding a metal insert pad to a metal substrate having multiple layered structures incorporating a metal (i.e., copper alloys) [Paragraphs 26-28], in order to facilitate the laser spot weld/absorption of laser light energy.

Current Application: 10/808,650	U.S. Patent 6,821,143 B2
Claim 1	Claims 1, 8, and 10-11
Claims 5, 17	Claims 1, 8, and 10-11

Allowable Subject Matter

4. Claims 3-4 and 7-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: To overcome the Double Patent rejection above, Applicant may also amend the base claims to incorporate the limitations of the Dependent claims above, which would not have been obvious to one ordinarily skilled in the art to modify the U.S. Patent No. 6,821,143 B2.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Han whose telephone number is (571) 272-2207. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason M Han
Examiner
Art Unit 2875

JMH (12/6/2006)


Sandra O'Shea
Supervisory Patent Examiner
Technology Center 2800